

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

42390P10476

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Signature

Typed or printed

name Katherine Jennings

Application No.

09/803,530

Filed

March 9, 2001

First Named Inventor

Paul S. Gyskiewicz

Art Unit

2178

Examiner

Adam L. Basehoar

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

NOTE: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under of 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ Attorney or agent of record.
Registration Number 39,926
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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September 05, 2006

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required.

☐ *Total of _____ forms are submitted.



Mail Stop AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/803,530
Inventor: Paul S. Gryskiewicz
Filed: March 9, 2001
Art Unit: 2178
Examiner: Basehoar, Adam L.
Attorney Docket No.: 042390.P10476
Customer No.: 25694
For: **Displaying Video In Application**

Confirmation No. 2833

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450
Alexandria, VA 22313-1450

On: September 5, 2006

Signature: 
Katherine Jennings

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action dated **June 2, 2006**, Applicant requests review of the final rejection in the above-identified application. This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets, which begin on page 2 of this Request for Review. No amendments are being filed with this request.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to Deposit Account No. 02-2666.

Request for Review

Applicant is submitting this Request for Review because Applicant believes that there are clear errors in the Examiner's rejection. Applicant will clearly show that the Examiner has failed to establish a *prima facie* case of obviousness.

Rejection under 35 U.S.C. § 103

The Examiner, on page 2 of the Final Office Action, has rejected claims 1-11, 13-29, and 31-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,572,649 to Elliott *et al.* (hereinafter "Fletcher") in view of U.S. Patent No. 5,636,371 to Yu. Applicant respectfully traverses this rejection. Based on the remarks set forth below, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

The Examiner has failed to establish a *prima facie* case of obviousness. Three criteria must be met to establish a *prima facie* case of obviousness. MPEP 2143. There must be some suggestion or motivation, either in the references themselves or in the knowledge available to one of skill in the art, to combine the references. *Id.* There must be a reasonable expectation of success. *Id.* And, lastly, the prior art references must teach or suggest all the claim limitations. *Id.* "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP 2143 (*citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness because the references cited by the Examiner, Elliott and Word 2000, do not suggest the combination or motivate one skilled in the art to combine them.

As indicated, the teachings or suggestions to combine must be found in Elliott and Word 2000, not in Applicant's patent application.

The present invention teaches "a controller to: display the video within an area of at least one object; and adjust a position of the at least one object in response to displaying the video, wherein to adjust the position of the at least one object comprises to arrange the at least one object in a manner so that both the video and the at least one object are prevented from having an impeded view." Unlike the present invention, Elliott teaches a process for dynamically switching between a single top level window and multiple top level windows. *Elliott*, Abstract; col. 2, lines 23-56; col. 6, line 15 – col. 7, line 22. With Elliott, a parent window (also referred to as a single top level window) having a plurality of child windows therein can be ungrouped to display the plurality of child windows as top level windows so that they may be manipulated and selectively positioned on the display by the user. *Id.* Elliott also has a group button to reposition the child windows back into the parent window to display the single top level window with associated child windows disposed therein. *Id.* In fact, in Figure 6, Elliott shows the electronic conferencing application window 92 overlapping the word processing window 88 displayed on screen 85. Unlike the present invention, in which the full text of the word processing window would be viewable, Elliott does not show the full text of the word processing window. In fact, Elliott is not concerned with the portions of the text being viewable where the electronic conferencing application window 92 overlaps the word processing window 88. Elliott is concerned with being able to ungroup the child windows 95 and 98 in the electronic conferencing application window 92 as shown in FIG. 8. A similar situation is shown in FIG. 8 of Elliott, in which Elliott does not

concern itself with enabling portions of text to be viewable where windows of the electronic conferencing application (95, 98, and 100) overlap the word processing window 88. Again, Elliott teaches ungrouping child windows from a parent window and regrouping the child windows back into the parent window. *Id.*

Word 2000 illustrates the ability to insert pictures into a word document while still being able to view the word document. *Word 2000*, pp. 3-9. Word 2000 also illustrates the ability to view the word document when the picture is being resized. *Id.*

Applicant respectfully submits that the Examiner has combined Elliott and Word 2000 based on Applicant's application disclosure. The Examiner's primary reference is Elliott. The Examiner admits, on page 3 of the Final Office Action, that "Elliott does not teach wherein the text and the video in the display window were both able to be positioned to be both viewable without obstruction." The Examiner then states that Word 2000 teaches this feature. Applicant respectfully asserts that nothing in Elliott suggests that the text and video in the display window need to be positioned so that both are viewable without obstruction. Also, nothing in Word 2000 suggests that this feature needs to be combined with the teachings of Elliott as well.

Thus, for at least the above stated reasons, Applicant strongly asserts that there is no motivation to modify Elliott with the teachings of Word 2000. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness. Applicant further asserts that claims 1-11, 13-29, and 31-36 are patentable over Elliott and Word 2000. Applicant therefore respectfully requests that the Final Office Action be reviewed and the

review result in the withdrawal of the finality of the Final Office Action dated June 2, 2006.

Respectfully submitted

Intel Corporation

Dated: September 5, 2006

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